

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re Application of: | Flemming TRAP <i>et al.</i> | Confirmation No.: | 8438 |
| Application No.: | 10/537,689 | Examiner: | Herrera, Diego D. |
| Filed: | December 20, 2002 | Group Art Unit: | 2617 |

For: AVAILABILITY SETTINGS IN MOBILE TERMINALS

Commissioner for Patents
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal dated March 15, 2011.

I. REAL PARTY IN INTEREST

The real party in interest is Nokia Corporation, a corporation organized under the laws of Finland and having a place of business at Keilalahdentie 4, FIN-02150 Espoo, Finland. The above referenced patent application is assigned to Nokia Corporation.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF THE CLAIMS

Claims 1 through 3, 5, 7 through 13, 15, 17 through 21, and 23 through 28 are pending in this Application. Claims 4, 6, 14, 16, and 22 were canceled. Claims 1 through 3, 5, 7 through

13, 15, 17 through 21, and 23 through 28 have been previously presented. No claims are original.

Claims 1 through 3, 5, 7 through 13, 15, 17 through 21, and 23 through 28 were finally rejected in an Office Action dated December 22, 2010. It is from the final rejection of claims 1 through 3, 5, 7 through 13, 15, 17 through 21, and 23 through 28 on December 22, 2010, that this Appeal is taken.

IV. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the issuance of the Final Office Action on December 22, 2010.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention addresses problems associated with availability settings on mobile communication terminals. An instant messaging (IM) program running as a background task in a mobile telephone associates an availability setting of the mobile telephone, the setting dependent on the profile to which the telephone is currently set. If an application is run or an activity commenced, this, and the availability setting associated with that application or activity, is detected. If the availability setting is higher, for example, such as because the setting indicates offline rather than online or unable to receive communications as opposed to able to receive communications, the network is informed of the new setting. Once the application or activity has ended, the availability settings are reset and the network informed of any revised setting. In this manner, a user does not need to manually adjust the availability settings on the mobile

communications terminal. The availability setting associated with each application, activity, and profile is individually user-definable.

Independent claim 1 recites:

1. A terminal, comprising:
a processor (See, e.g., Specification, page 3, line 17-page 4, line 14; Fig. 1, CPU 11); and
at least one memory including computer program code (See, e.g., Specification, page 3, line
17-page 4, line 14; Fig. 1, ROM 15),
the at least one memory and the computer program code configured to, with the processor,
cause the terminal to perform at least the following,
detect commencement of an activity or running of an application associated with a first
setting (See, e.g., Specification, page 7, lines 27-29; Fig. 2, steps 31 and 32);
retrieve a second setting associated with a selected operating profile (See, e.g., Specification,
page 7, lines 27-32; Fig. 2, steps 32 and 33);
select, without input from a user, a more restrictive setting based on a comparison of the first
setting and the second setting (See, e.g., Specification, page 1, lines 26-27, page 5, lines
1-3, page 7, line 29-page 8, line 12; Fig. 1; Fig. 2, steps 31 and 32);
adjust an availability setting of the terminal to the more restrictive setting (See, e.g.,
Specification, page 2, lines 10-15, page 4, line 16-page 5, line 3, page 5, line 28-page 6,
line 14; page 8, lines 5-12; Fig. 1; Fig. 2, step 38); and
report of the adjusted availability setting to or via a network (See, e.g., Specification,
page 3, lines 4-5, page 6, lines 16-23, page 8, lines 9-11; Fig. 1; Fig. 2, step 39).

Independent claim 11 recites:

11. A method comprising:

detecting commencement of an activity or the running of an application associated with a first

setting (See, e.g., Specification, page 7, lines 27-29; Fig. 2, steps 31 and 32);

retrieving a second setting associated with a selected operating profile (See, e.g.,

Specification, page 7, lines 27-32; Fig. 2, steps 32 and 33);

selecting, without input from a user, a more restrictive setting based on a comparison of the

first setting and the second setting (See, e.g., Specification, page 1, lines 26-27, page 5,

lines 1-3, page 7, line 29-page 8, line 12; Fig. 1; Fig. 2, steps 31 and 32);

adjusting an availability setting of a mobile communication terminal to the more restrictive

setting (See, e.g., Specification, page 2, lines 10-15, page 4, line 16-page 5, line 3, page 5,

line 28-page 6, line 14; page 8, lines 5-12; Fig. 1; Fig. 2, step 38); and

causing, at least in part, reporting of the adjusted availability setting to or via a network (See,

e.g., Specification, page 3, lines 4-5, page 6, lines 16-23, page 8, lines 9-11; Fig. 1; Fig. 2,

step 39).

Independent claim 21 recites:

21. An apparatus comprising:

at least one processor (See, e.g., Specification, page 3, line 17-page 4, line 14; Fig. 1, CPU

11); and

at least one memory including computer program code(See, e.g., Specification, page 3, line 17-page 4, line 14; Fig. 1, ROM 15),
the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform at least the following,
detect commencement of an activity or running of an application associated with a first setting (See, e.g., Specification, page 7, lines 27-29; Fig. 2, steps 31 and 32);
retrieve a second setting associated with a selected operating profile (See, e.g., Specification, page 7, lines 27-32; Fig. 2, steps 32 and 33);
select, without input from a user, a more restrictive setting based on a comparison of the first setting and the second setting (See, e.g., Specification, page 1, lines 26-27, page 5, lines 1-3, page 7, line 29-page 8, line 12; Fig. 1; Fig. 2, steps 31 and 32);
adjust an availability setting of a communication terminal to the more restrictive setting (See, e.g., Specification, page 2, lines 10-15, page 4, line 16-page 5, line 3, page 5, line 28-page 6, line 14; page 8, lines 5-12; Fig. 1; Fig. 2, step 38); and
report the adjusted availability setting to or via a network (See, e.g., Specification, page 3, lines 4-5, page 6, lines 16-23, page 8, lines 9-11; Fig. 1; Fig. 2, step 39).

VI. **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1 through 3, 5, 7 through 13, 15, 17 through 21, and 23 through 28 were rejected under 35 U.S.C. §102(e) for anticipation predicated upon Doss et al. (“Doss”) (US 2003/0046296).

VII. ARGUMENT**GROUPING OF CLAIMS**

For the convenience of the Honorable Board of Patent Appeals and Interferences (“Board”), Appellants do not separately argue the patentability of any dependent claim. Instead, the patentability of all dependent claims stands and falls with their respective independent claims, i.e., independent claims 1, 11, and 21.

CLAIMS 1 THROUGH 3, 5, 7 THROUGH 13, 15, 17 THROUGH 21, AND 23 THROUGH 28 ARE NOT ANTICIPATED BY DOSS

The Examiner bears the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision. *Gilbert & P. Hyatt v. Dudas*, 551 F.3d 1307, 1313 (Fed. Cir. 2008); *In re Glaug*, 283 F.3d 1335 (Fed. Cir. 2002); *In re Rijkaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1992); *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984). To anticipate a patent claim, the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Therasense Inc. v. Becton, Dickinson and Co.*, 593 F3d 1325 (Fed. Cir. 2010); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003), *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001).

Additionally, “[u]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations **arranged or combined in the same way** as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102” (*see, Id. Therasense* quoting *Net moneyIN, Inc. v. VeriSign, Inc.*, 535 F.3d 1359 (Fed. Cir. 2008)) (emphasis added).

Although “inherent disclosure” is also a basis of anticipation, (*see, Finnigan Corp. v. Int’l Trade Comm’n*, 180 F.3d 1354, 1365 (Fed. Cir. 1999)), it “does not alter the requirement that all elements must be disclosed in an anticipatory reference in the same way they are arranged or combined in the claim” (*see, Id. Therasense*,). “[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation.”” (*see, Id.* quoting *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 (Fed. Cir. 2002)). “Inherency, however, **may not be established by probabilities or possibilities**. The mere fact that a certain thing may result from a given set of circumstances is not sufficient” (*see, Id.* quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)) (emphasis added).

Independent claims 1 and 21 recite, *inter alia*, “select, without input from a user, a more restrictive setting based on a comparison of the first setting and the second setting.” Independent claim 11 recites, *inter alia*, “selecting, without input from a user, a more restrictive setting based on a comparison of the first setting and the second setting.” Doss does not disclose this claim feature.

The Examiner asserted, at page 2 of the Final Office Action, that the derivation of dynamic contact information from calendar preferences and organizational directory in Doss corresponds to the claimed “first setting” and that “the operational of the different system the

user is related to such as the IM system and electronic status boards which are automatically updated” [sic] corresponds to the claimed second setting, concluding, “hence when these systems are updated the publish information is compared and updated with the most relevant information, hence selected without the user’s input, and the more restrictive information is therefore determined and used” [sic].

The Examiner is not entirely clear as to what, exactly, in Doss corresponds to the claimed first and second settings. However, to whatever extent there is a comparison of calendar information to update the status of a user, as described in paragraph [0015] of Doss, there is no disclosure, and not even a suggestion, in Doss that this comparison, or any comparison, is the basis for selection of “a more restrictive setting.”

The Examiner merely cited paragraphs [0008], [0014]-[0022], and [0053] of Doss and concluded therefrom that Doss “teaches selection is made by user of going from status setting to another, one of them being more restrictive, however this is a user choice” [sic] (Final Office Action-page 6). It is not clear what, in these cited paragraphs of Doss is being interpreted as the claimed “more restrictive setting.” However, no matter in what manner the Examiner is interpreting Doss to disclose anything corresponding to a “more restrictive setting,” Doss clearly does not disclose any selection of a “more restrictive setting” **based on a comparison of the first setting and the second setting.**

Moreover, the specification is very specific as to the definition of a “more restrictive setting.” In particular, paragraph [0023] of the Published application (page 6, lines 4 *et seq.* of the specification, as filed) recites, “An availability setting can be considered to be higher if it is more restrictive as to the availability of the mobile telephone 10 to communications from users connected to the network N.” Thus, in accordance with the disclosure of the present application,

a more “restrictive” setting is a “higher” setting and a higher setting in the examples is more “restrictive” such that offline is higher than online and not being able to receive communications is higher than being able to receive communications. Doss fails to disclose anything that would even suggest, much less disclose, a selection, without input from a user, of “a more restrictive setting based on a comparison of the first setting and the second setting,” where a “more restrictive setting” must be interpreted as defined by Appellants.

Accordingly, since the Examiner has erred in failing to present a *prima facie* case of anticipation with regard to the subject matter of claims 1 through 3, 5, 7 through 13, 15, 17 through 21, and 23 through 28, and rejection of these claims under 35 U.S.C. §102(e) is not factually viable, reversal of this rejection by the Honorable Board is respectfully solicited.

VIII. CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, it is apparent that none of the Examiner’s rejections under 35 U.S.C. §102(e) is factually or legally viable. Appellants therefore solicit the Honorable Board to reverse each of the Examiner’s rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

May 16, 2011

Date

/Phouphanomketh Ditthavong/

Phouphanomketh Ditthavong
Attorney/Agent for Applicant(s)
Reg. No. 44658

Errol A. Krass

Attorney/Agent for Applicant(s)
Reg. No. 60090

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9952
Fax (703) 519-9958

IX. CLAIMS APPENDIX

1. A terminal, comprising:

a processor; and

at least one memory including computer program code,

the at least one memory and the computer program code configured to, with the processor,

cause the terminal to perform at least the following,

detect commencement of an activity or running of an application associated with a first setting;

retrieve a second setting associated with a selected operating profile;

select, without input from a user, a more restrictive setting based on a comparison of the first setting and the second setting;

adjust an availability setting of the terminal to the more restrictive setting; and

report of the adjusted availability setting to or via a network.

2. A terminal as claimed in claim 1, the availability setting is adjusted depending on the identity of the application or the activity.

3. A terminal as claimed in claim 2, in which the first setting is user definable.

4. (Canceled)

5. A terminal as claimed in claim 1, in which the second setting is user definable.

6. (Canceled)

7. A terminal as claimed in claim 1, wherein the adjustment of the availability setting is responsive to the ending of the activity or the ceasing of the running of the application to restore the availability setting to its previous setting.

8. A terminal as claimed in claim 1, wherein the terminal is further caused, at least in part, to allow a user to define a different availability setting for a predetermined network user or a group of network users to a setting associated with other users.

9. A terminal as claimed in claim 1, wherein the terminal is further caused, at least in part, to queue one or more communications received in contravention of an availability setting without revealing the one or more communications to the user.

10. A terminal as claimed in claim 1, wherein the terminal is further caused, at least in part, to, in response to the receipt of a communication in contravention of an availability setting, automatically send a reply communication.

11. A method comprising:

detecting commencement of an activity or the running of an application associated with a first setting;

retrieving a second setting associated with a selected operating profile;
selecting, without input from a user, a more restrictive setting based on a comparison of the first setting and the second setting;

adjusting an availability setting of a mobile communication terminal to the more restrictive setting; and

causing, at least in part, reporting of the adjusted availability setting to or via a network.

12. A method as claimed in claim 11, in which the adjusting step includes adjusting the availability setting depending on the identity of the application or the activity.
13. A method as claimed in claim 12, in which the first setting is user definable.
14. (Canceled)
15. A method as claimed in claim 11, in which the second setting is user definable.
16. (Canceled)
17. A method as claimed in claim 11, comprising detecting the ending of the activity or the ceasing of the running of the application, and in response to a detection restoring the availability setting to its previous setting.
18. A method as claimed in claim 11, further comprising allowing a user to define a different availability setting for a predetermined network user or a group of network users to a setting associated with other users.
19. A method claimed in claim 11, further comprising queuing one or more communications received in contravention of an availability setting without revealing the one or more communications to the user.
20. A method as claimed in claim 11, further comprising automatically sending in response to the receipt of a communication in contravention of an availability setting a reply communication.
21. An apparatus comprising:

at least one processor; and

at least one memory including computer program code,

the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform at least the following,

detect commencement of an activity or running of an application associated with a first setting;

retrieve a second setting associated with a selected operating profile;

select, without input from a user, a more restrictive setting based on a comparison of the first setting and the second setting;

adjust an availability setting of a communication terminal to the more restrictive setting; and report the adjusted availability setting to or via a network.

22. (Canceled)

23. The apparatus as claimed in claim 21, wherein the apparatus is further caused, at least in part, to allow a user to define a different availability setting for a predetermined network user or a group of network users to a setting associated with other users.

24. The apparatus as claimed in claim 21, wherein the availability setting is adjusted depending on the identity of the application or the activity.

25. The apparatus as claimed in claim 21, wherein the first setting and the second setting are user definable.

26. The apparatus as claimed in claim 21, wherein the adjustment of the availability setting is responsive to the ending of the activity or the ceasing of the running of the application to restore the availability setting to its previous setting.

27. The apparatus as claimed in claim 21, wherein the apparatus is further caused, at least in part, to allow a user to define a different availability setting for a predetermined network user or a group of network users to a setting associated with other users.

28. The apparatus as claimed in claim 21, wherein the apparatus is further caused, at least in part, to, in response to the receipt of a communication in contravention of an availability setting, to automatically send a reply communication.

X. EVIDENCE APPENDIX

Appellants are unaware of any evidence that is required to be submitted in the present Evidence Appendix.

XI. RELATED PROCEEDINGS APPENDIX

Appellants are unaware of any related proceedings that are required to be submitted in the present Related Proceedings Appendix.